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REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed November 10, 2005.

In the Office Action, the Examiner notes that claims 1, 2, 5, 7-10, 13, and 14 are pending of which claims 1, 2, 5, 7-10, 13, and 14 are pending stand rejected. By this response claims 1, 5, 9, and 10 are amended.

In view of the foregoing amendments and the following discussion, Applicants submit that none of the claims now pending in the application are anticipated or obvious under the respective provisions of 35 U.S.C. §102 or §103. Applicants submit that the none of the claims now pending in the application fails to comply with the written description requirement under the respective provisions of 35 U.S.C. §112. Thus, Applicants believe that all of these claims are now in allowable form.

It is to be understood that Applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

REJECTIONS

35 U.S.C. §112

Claims 1, 2, 9, 10, 13 and 14

The Examiner has rejected claims 1, 2, 9, 10, 13 and 14 under 35 U.S.C. §112, ¶1, as failing to comply with the written description requirement. Applicants respectfully traverse the rejection by amending claims 1, 5, 9, and 10.

35 U.S.C. §102

Claims 5 and 8

The Examiner has rejected claims 5 and 8 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 5,986,650 to Ellis et al. (Ellis). Applicants respectfully traverse the Examiner's rejection.

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"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim" (Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). The Ellis reference fails to disclose each and every element of the claimed invention, as arranged in the claims.

Applicant's independent claim 5 recites:

5.   A method, comprising:
      generating, at a headend, a plurality of bitmaps for each of a plurality of channel information windows;
      encoding, at the headend, a plurality of broadcast video displays and the channel information windows, the broadcast video displays including a particular broadcast video display, each broadcast video display being programming from one of a plurality of channels, the channel information windows including information about the channels;
      transmitting, from the headend to the set top terminal, the broadcast video displays and the channel information windows;
      decoding, at the set top terminal, the broadcast video displays and the channel information windows;
      compositing, at the set top terminal, the particular broadcast video display and an associated one of the channel information windows to produce a video stream for a display so that the channel information window overlays and obscures at least a portion of the particular broadcast video display; and
      changing, at the set top terminal, the channel information window in response to a navigation command in a mode, while the particular broadcast video display remains the same. (Emphasis added.)

Ellis discloses a scan feature for an electronic television program guide schedule system. The set top cable converter box shown in Figure 1 includes a video display generator 23 that has a RGB video generator 24 and a video overlay device 25. Thus, in Ellis, the set top cable generates the bitmaps. (Ellis, Figure 1, col. 6, lines 27-44.) In contrast, the claimed invention generates bitmaps for channel information windows at a headend, not at the set top terminal as in Ellis.

Prior art, such as Ellis, generated overlaying windows at the set top terminal. The claimed invention generates channel information windows at a headend. Because the window is generated at the headend rather than at the set top terminal, the set top

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terminal may be simplified and made less expensively. For example, the set top terminal can omit the video generator. Therefore, the claimed invention has at least this advantage over prior art such as Ellis.

Ellis fails to teach or suggest each and every element of Applicant's invention of at least claim 5. Namely, Ellis fails to teach or suggest at least the limitation of generating a bitmap for the channel information windows at the headend.

Thus, the teachings of Ellis are completely different from the teachings of Applicant's invention of at least claim 5. As such, Ellis fails to teach or suggest each and every element of Applicant's invention, as arranged in the claim.

Therefore, Applicant submits that independent claim 5 is not anticipated and fully satisfies the requirements of 35 U.S.C. §102 and is patentable thereunder. Furthermore, independent claims 1, 9, and 10 recite features substantially similar to the features of claim 5. As such, for at least the reasons discussed above with respect to claim 5, independent claims 1, 9, and 10 are also not anticipated by Ellis and fully satisfy the requirements of 35 U.S.C. §102 and is patentable thereunder.

Accordingly, Applicant submits that claims 1, 5, 9, and 10 are not anticipated and fully satisfy the requirements of 35 U.S.C. §102 and are patentable thereunder. Furthermore, claims 2, 7, 8, 13, and 14 depend, either directly or indirectly, from independent claims 1, 5, 9, and 10 and recite additional limitations therefor. As such, and for at least the same reasons as discussed above with respect to claim 5, Applicant submits that these dependent claims are also not anticipated and fully satisfy the requirements of 35 U.S.C. §102 and are patentable thereunder. Therefore, Applicant respectfully requests that the rejection be withdrawn.

Rejection under 35 U.S.C. §103 of Claims 1, 2, and 7

The Examiner has rejected claims 1, 2, and 7 under 35 U.S.C. §103(a) as being unpatentable over Ellis in view of U.S. Patent 5,485,197 to Hoarty (Hoarty). Applicants respectfully traverse the Examiner's rejection.

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather, the test is whether the

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claimed invention, considered <u>as a whole</u>, would have been obvious. <u>Jones v. Hardy</u>, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. <u>In re Wright</u>, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The Ellis and Hoarty references, alone or in combination, fail to teach or suggest all of the limitations recited in claim 1, and thus fail to teach or suggest the Applicants' invention as a whole.

Applicant's independent claim 1 recites:

1.   A method, comprising:
generating, at a headend, at least one bitmap for a channel information window;
encoding, at the headend, a broadcast video presentation and the bitmap for the channel information window, the broadcast video presentation being programming from one of a plurality of channels;
transmitting, from the headend to a set top terminal, the bitmap for the broadcast video presentation and the bitmap for the channel information window;
receiving, at the set top terminal, a signal to activate the channel information window;
decoding, at the set top terminal, the bitmap for the broadcast video presentation and the bitmap for the channel information window; and
compositing, at the set top terminal, the bitmap for the channel information window and the bitmap for the broadcast video presentation to produce a video stream for a display so that the channel information window overlays and obscures at least a portion of the broadcast video presentation on the display. (Emphasis added.)

Specifically, Ellis and Hoarty, alone or in combination, fail to teach or suggest at least generating a bitmap for a channel information window at a headend, as claimed.

As discussed above, Ellis fails to disclose at least this element.

Furthermore, Hoarty fails to bridge the substantial gap between the Ellis reference and Applicants' invention as recited in claim 1. Hoarty discloses an interactive home information system for generating a display of a carousel for subscribers in a cable television system. However, Hoarty does not teach or suggest teach or suggest the claimed generation of a bitmap for a channel information window at a headend.

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Nowhere in Hoarty is there any teaching or suggestion of generating a bitmap for a channel information window at a headend. There is no mention at all of any such channel information window, nor of generating a bitmap for one. (Hoarty, col. 5, lines 15-45, col. 7, lines 36-65.)

As such, Applicants submit that independent claim 1 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Moreover, independent claims 5, 9, and 10 contain substantially similar relevant limitations as those discussed above in regards to claim 1. As such, Applicants submit that independent claims 5, 9, and 10 are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 2, 7, 8, 13, and 14 depend, either directly or indirectly, from independent claims 1, 5, 9, and 10 and recite additional limitations thereof. As such, and for at least the same reasons as discussed above, Applicants submit that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder.

Therefore, Applicants respectfully request that the rejection of such claims under 35 U.S.C. §103(a) be withdrawn.

Rejection under 35 U.S.C. §103 of Claims 9 and 10

The Examiner has rejected claims 9 and 10 under 35 U.S.C. §103(a) as being unpatentable over Ellis in view of U.S. Patent 5,579,055 to Hamilton et al. (Hamilton).

Applicant's independent claim 9 recites:

9.   A method, comprising:
generating, at a headend, a broadcast video presentation and at least one bitmap for a channel information window, the broadcast video presentation being programming from one of a plurality of channels;
encoding, at the headend, the broadcast video presentation and the bitmap for the channel information window;
transmitting, from the headend to a terminal, the broadcast video presentation and the channel information window; and
sending, from the terminal to the headend, a signal to activate the channel information window;
wherein the bitmap for the channel information window is overlaid over the broadcast video presentation so that the channel information window obscures at least a portion of the broadcast video presentation. (Emphasis added.)

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Applicant's independent claim 10 recites:

10.   A method, comprising:
    receiving, at a terminal from a headend, a broadcast video
presentation, the broadcast video presentation being programming from
one of a plurality of channels;
    sending, to the headend from the terminal, a signal to activate a
channel information window;
    **receiving, at the terminal from the headend, a bitmap for the
channel information window;**
    decoding, at the terminal, the broadcast video presentation and the
channel information window; and
    compositing, at the terminal, the bitmap for the channel information
window with the broadcast video presentation to produce a video stream
for display so that the channel information window overlays and obscures
at least a portion of the broadcast video presentation in the video stream.
(Emphasis added.)

Ellis and Hamilton, alone or in combination, fail to teach or suggest at least
generating a bitmap for a channel information window at a headend or receiving the
bitmap for the channel information window at the terminal from the headend, as
claimed.

As discussed above, Ellis fails to disclose at least this element.

Furthermore, Hamilton fails to bridge the substantial gap between the Ellis
reference and Applicants' invention as recited in claim 1. Hamilton discloses an
electronic program guide and text channel data controller. However, Hamilton does not
teach or suggest teach or suggest the claimed generating a bitmap for a channel
information window at a headend or receiving the bitmap for the channel information
window at the terminal from the headend.

Nowhere in Hamilton is there any teaching or suggestion of generating a bitmap
for a channel information window at a headend. There is no mention at all of any such
channel information window, nor of generating a bitmap for one.

As such, Applicants submit that independent claims 9 and 10 are not obvious
and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder.

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Therefore, Applicants respectfully request that the rejection of such claims under 35
U.S.C. §103(a) be withdrawn.

Rejection under 35 U.S.C. §103 of Claim 13

The Examiner has rejected claim 13 under 35 U.S.C. §103(a) as being
unpatentable over Ellis and Hoarty as applied to claim 1 above, and further in view of
U.S. Patent 5,793,364 to Bolanos et al. (Bolanos).

Ellis, Hoarty, and Bolanos, alone or in combination, fail to teach or suggest at
least generating a bitmap for a channel information window at a headend or receiving
the bitmap for the channel information window at the terminal from the headend, as
claimed.

As discussed above, Ellis and Hoarty fail to render claim 1 obvious and claim 13
depends from claim 1.

Furthermore, Bolanos fails to bridge the substantial gap between the Ellis and
Hoarty references and Applicants' invention as recited in claim 1. Bolanos discloses a
method and system for associating playback of multiple audiovisual programs with one
graphic interface element. However, Bolanos does not teach or suggest teach or
suggest the claimed generating a bitmap for a channel information window at a
headend.

Nowhere in Bolanos is there any teaching or suggestion of generating a bitmap
for a channel information window at a headend. There is no mention at all of any such
channel information window, nor of generating a bitmap for one.

As such, Applicants submit that dependent claim 13 is not obvious and fully
satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Therefore,
Applicants respectfully request that the rejection of such claims under 35 U.S.C.
§103(a) be withdrawn.

Rejection under 35 U.S.C. §103 of Claim 14

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The Examiner has rejected claim 14 under 35 U.S.C. §103(a) as being unpatentable over Ellis and Hoarty as applied to claim 1 above, and further in view of MacInnis U.S. Patent 5,951,639 (MacInnis).

Ellis, Hoarty, and MacInnis, alone or in combination, fail to teach or suggest at least generating a bitmap for a channel information window at a headend, as claimed.

As discussed above, Ellis and Hoarty fail to render claim 1 obvious and claim 14 depends from claim 1.

Furthermore, MacInnis fails to bridge the substantial gap between the Ellis and Hoarty references and Applicants' invention as recited in claim 1. MacInnis discloses a system for downloading different versions of software or data modules into a plurality of terminals having different compatibility interfaces. However, MacInnis does not teach or suggest teach or suggest the claimed generating a bitmap for a channel information window at a headend.

Nowhere in MacInnis is there any teaching or suggestion of generating a bitmap for a channel information window at a headend. There is no mention at all of any such channel information window, nor of generating a bitmap for one.

As such, Applicants submit that dependent claim 14 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Therefore, Applicants respectfully request that the rejection of such claims under 35 U.S.C. §103(a) be withdrawn.

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CONCLUSION

Thus, Applicants submit that none of the claims presently in the application, are indefinite or obvious under the respective provisions of 35 U.S.C. §§112 and 103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues, it is requested that the Examiner telephone Eamon J. Wall, Esq. at (732) 530-9404 or Lea Nicholson at (732) 383-1396 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: _____1/30/06_____   _____
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